

Appl No. : 10/733,063
Amdt. Dated: February 21, 2006
Reply to Office action of : October 5, 2005

REMARKS / ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action and amended as necessary to more clearly and particularly describe the subject matter which Applicant regards as the invention.

Initially, applicant notes that the Examiner has twice failed to initial reference R on applicant's IDS. The Examiner crossed out references L, M, and R on applicant's IDS filed with the application. These references were cited in application number 09/982,290 from which priority is claimed under 35 USC §120. Accordingly, applicant need not provide copies of these references. A second form 1449 listing only references L, M, and R was provided with applicant's response to the first Office action. The Examiner only initialed references L and M on this form and failed to initial reference R. For the Examiner's convenience, a new form 1449 listing only reference R is included. This submission is considered timely because this reference was cited when the application was filed. Applicant requests that the new form 1449 be initialed to confirm that the Examiner has considered this reference.

Claims 1 and 20 have been amended.

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Moro et al. (U.S. patent number 5,045,266) in view of Stanton (5,185,802). The Examiner asserts that it would be obvious to combine the teachings of Moro and Stanton to arrive at the claimed invention. The Examiner has blended the two diverse teachings together with a level of balance between the two diverse teachings to arrive at the claimed invention. The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. See MPEP § 2143. In this case, there is no suggestion

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in the prior art of record of the desirability of the combination offered by the Examiner. It would not have been obvious to the person of ordinary skill in the art to merely blend the teachings to arrive at something that is different from, and no longer contains, either of the two initial structures. Absent access to the subject application, it would not have been obvious to one skilled in the art to combine the cited references to arrive at the claimed invention. As such, it is the present application that is the true teaching, and the Examiner is impermissibly using hindsight in combining the Moro and Stanton references. Moreover, when the claimed invention is considered as a whole, and not merely compared limitation-by-limitation to the prior art, it is clear that the claimed invention is not obvious and patentable.

The Examiner asserts that it would be obvious to combine the teachings of Moro and Stanton in order to “provide a means to maintain hygienic contact with an individual’s skin over a prolonged period of time - as would be *necessary* with any hearing aid device” (emphasis added). Assuming, *arguendo*, that a hearing aid must *necessarily* maintain hygienic contact with an individual’s skin over a prolonged period of time, it does not follow that one of ordinary skill in the art would be motivated to combine the diverse teachings of Moro and Stanton. At best, one of ordinary skill in the art would be motivated to regularly clean or replace either of Moro’s and Stanton’s respective hearing aid and shell, in order to maintain hygienic contact with an individual’s skin. In fact, Moro specifically teaches a hearing aid that can be cleaned with conventional cleansers. See col. 2, lines 30-31. It is the applicant who recognized the desirability of an exchangeable shell for applying a substance to the human body during predetermined time intervals. Absent access to the present application, it would not have been obvious to combine the teachings of Moro and Stanton to arrive at the claimed invention.

For at least the reasons discussed above, there is insufficient basis to form a *prima facie* case of obviousness, as required to support a rejection under 35 U.S.C. § 103(a). Therefore, the rejection

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of claim 1 should be withdrawn.

Claims 3, 4, and 17-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moro in view of Stanton. Claims 3, 4, and 17-19 each depend from claim 1. For at least the reasons discussed above with respect to claim 1, the rejections of claims 3, 4, and 17-19 should be withdrawn.

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Moro in view of Stanton. As discussed above with respect to claim 1, there is insufficient basis to form a *prima facie* case of obviousness, as required to support a rejection under 35 U.S.C. § 103(a). Therefore, the rejection of claim 20 should be withdrawn.

Claims 23, 24, 27, and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moro in view of Stanton. Claims 23, 24, 27, and 28 each depend from claim 20. For at least the reasons discussed above with respect to claim 20, the rejections of claims 23, 24, 27, and 28 should be withdrawn.

Claims 5-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moro in view of Stanton and in view of Zaffaroni (U.S. patent number 3,996,934). Claims 5-16 each depend from claim 1. For at least the reasons discussed above with respect to claim 1, the rejections of claims 5-16 should be withdrawn. Furthermore, applicant submits that there is insufficient motivation to modify the teachings of Moro and Stanton based on the teachings of Zaffaroni to arrive at the present invention. The Examiner states that the modification is obvious because the combination would provide "improved transdermal drug delivery." However, there is nothing in the prior art of record that indicates that one of ordinary skill in the art, at the time the invention was made, would have been motivated to incorporate aspects of a *medical bandage* apparatus into a *hydrophilic composite earmold* as taught by Moro or a *modular hearing aid* as taught by Stanton. In this case, the Examiner is impermissibly using hindsight in combining Zaffaroni with the Moro and Stanton references. Therefore, a *prima facie* case of obviousness sufficient to support a rejection under 35 U.S.C. 103(a)

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has not been made, and thus the rejection should be withdrawn.

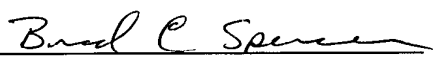
Claims 21, 25, and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moro in view of Stanton and in view of Zaffaroni. Claims 21, 25, and 26 each depend from claim 20. For at least the reasons discussed above with respect to claim 20, the rejections of claims 21, 25, and 26 should be withdrawn. As discussed above with respect to claims 5-16, a *prima facie* case of obviousness sufficient to support a rejection under 35 U.S.C. 103(a) has not been made, and thus the rejection should be withdrawn.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32784US5.

Respectfully submitted,

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